## REMARKS

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed January 31, 2006. Applicants respectfully submit that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 11, 35, 41 and 48 are amended, claims 2 – 4, 10 – 16, and 35 – 54 remain pending, and claims 1, 5 – 9, and 17 – 34 remain cancelled. Applicants reserve the right to pursue the subject matter of the cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the cancelled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### I. Examiner Interview

Applicants first wish to express their sincere appreciation for the time that Examiner Ouellette spent with Applicants' Attorney, Jeffrey R. Kuester, during general telephone discussions on April 5, 2006, and April 7, 2006. During those conversations, Examiner Ouellette explained concerns under 35 U.S.C. §112, first paragraph, regarding the pending independent claims. The amendments made herein are designed to clarify various claim elements. Thus, Applicants respectfully request that Examiner Ouellette carefully consider this response and the amendments.

### II. Rejections Under 35 U.S.C. §112

The Office Action indicates that the independent claims stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and distinctly claim the subject matter which Applicants regard as the invention. While Applicants submit that the claims as previously pending were allowable as written, Applicants have nonetheless amended these claims in the interest of advancing prosecution. With regard to one example embodiment, among others, the written description requirement for the amended features is

addressed in the present application on pages 169 - 200. Accordingly, Applicants submit that the claims as currently pending are clearly allowable.

## III. Rejections Under 35 U.S.C. §102(e)

The Office Action indicates that claims 11 – 13 and 48 – 50 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Number 6,298,327 ("*Hunter*"). Applicants respectfully traverse these rejections on the grounds that *Hunter* does not disclose determining an intellectual property licensing rights marketing opportunity score. Instead, *Hunter* discloses facilitating evaluation of market value of an invention itself, which is very distinct from the claimed feature. Moreover, there are additional separately distinguishing elements of claims 11 – 13 and 48 – 50.

## IV. Rejections Under 35 U.S.C. §103

The Office Action indicates that claims 2 – 4, 10, 14 – 16, and 35 – 47, and 51 – 54 are rejected under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent Number 6,298,327 ("*Hunter*"), in combination with findings of Official Notice and allegedly non-functional descriptive material. Applicants respectfully traverse these rejections on the grounds that *Hunter* does not disclose determining or generating an intellectual property licensing rights marketing opportunity score. Instead, *Hunter* discloses facilitating evaluation of market value of an invention itself, which is very distinct from the claimed feature. The findings of Official Notice and allegedly non-functional descriptive material do not remedy this deficiency of *Hunter*. There are also additional separately distinguishing elements of the presently pending independent and dependent claims.

Regarding the findings of alleged nonfunctional descriptive data and Official Notice, Applicants first submit that those findings are now rendered moot. In addition, however, Applicants do not admit that any of the claimed differences are found only in nonfunctional descriptive data or are not functionally involved in the claims. Furthermore, Applicants submit that the subject matter of the Official Notice findings should not be considered well known for at least the specific and particular reason that the findings are too complex to be suitable for Official Notice. More specifically, the Office Action states that "marketing analysis of Intellectual Property was well known at the time the invention was made, to include the

assessment between obtaining intellectual property protection and maintaining the intellectual property as an in-house trade secret (Coca-Cola's maintenance of soda formulations as Trade Secrets – decision determined by analyzing long-term impact of releasing formulas to public)." This finding regarding Coca-Cola's decision regarding its trade secret is not supported by any evidence, thus the conclusion is without support in fact. The Office Action also states that "intellectual property marketing/business assessments were well known at the time the invention was made, to include the assessment techniques/criterions disclosed in claims 36 – 38 and 42 – 45." Notably, the Office Action does not include any factual support for this conclusion of Official Notice. Accordingly, Applicants request valid findings of fact in support of the conclusions of alleged Official Notice or withdrawal of the conclusions.

## CONCLUSION

In conclusion, Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims be allowed to issue.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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